

PATENT
P56988**REMARKS**

This Amendment is prepared in response to the first Office action mailed on 13 April 2005 (Paper No. 04072005).

Status of the Claims

Claims 1 through 16 are pending in the application. Claims 8, 9, 10, 12, 14 and 15 are amended while independent claim 16 is newly presented.

Objection to the Drawings under 37 C.F.R. §1.83(a)

The drawings are objected to under 37 C.F.R. §1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the Examiner requires indication of the conveyor elements, insertion stations, adhesion stations, collection stations, and conveyor devices in the drawings. In the first instance, the attention of the Examiner is invited to note that "conveyor elements" is used collectively to refer, in the aggregate, to the several constituent components of the various conveyors described in the *Detailed Description*, several of which components are individually shown in the drawings.

In the second instance, the attention of the Examiner is directed to note that rather than the nominative phrase "insertion station" mentioned in Paper No. 04072005, Applicant illustrates "inserting station 58", with some degree of detail, in Figure 3. Moreover, the *Brief Description of the Drawings*, among other portions of Applicant's specification, expressly identifies this feature.

In the third instance, the Examiner questioned that absence of "adhesion stations" and

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“collection stations” in the drawings. These assemblies are conventional, and their respective connections to Applicant’s invention are duly represented by the, insertion station illustrated in Figure 3, in conformance with the last clause of 37 CFR §1.83(b). As explained in paragraph [0010] of Applicant’s original specification, “adhesive binding is shown in detail in EP-A1-0675005.” Although Figure 3 represents an inserting station which is located “radially on the inside”¹, what is significant here is the “large accessibility radially on the inside as well as radially on the outside and from the side ... possible to provide further working stations along the revolving path 31 ...”² Figure 3 provides an exemplary degree of illustration of these connections between these different constituent components of Applicant’s inventions, in conformance with the last clause of 37 CFR §1.83(b). Accordingly, reconsideration of this requirement is respectfully requested. Should, upon reconsideration, the Examiner deemed that amended drawings are necessary, or even desirable, Applicant will submit additional figures using boxes to represent “adhesion stations” and “collection stations”.

In the fourth instance, the Examiner questioned the absence of “conveyor devices” in the drawings. The Examiner is respectfully invited to note “conveyor device 30” among features shown in Figure 5.

Objection to the Abstract

The Abstract is objected to as containing the word “means.” The Abstract has been amended

¹ Original Specification, paragraph [0047], line 3.

² Original Specification, paragraph [0047], lines 2 and 3.

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to delete "means" and to reduce word count, in compliance with the newly amended rule governing the length of the Abstract.

Claim Rejection Under 37 C.F.R. §112

Claims 1 through 15 are rejected under the second paragraph of 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With the exception below noted, claims 8, 9, 10, 12, 14 and 15 are amended to omit those phrases questioned by the Examiner.

In the one exception, the Examiner questioned the presence of "means" in claim 1, and asserted that "it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph." Contrary to this assertion, the scope of claim 1 is determined by the prior art, and not by a notion of equivalents. Moreover, the sixth paragraph of 35 U.S.C. §112 is permissive, and places no requirement for inclusion of specific limitations in any claim; nothing in pending claim 1 violates the sixth paragraph of 35 U.S.C. §112. This rejection is not supported by any provision of the sixth paragraph of 35 U.S.C. §112; its withdrawal is therefore respectfully urged.

Claim Rejection Under 35 U.S.C. §102

Claims 1 through 15 are rejected under 35 U.S.C. §102(b) as being anticipated by Müller, U.S. Patent No. 5,562,278. Applicant traverses this rejection for the following reasons.

In support of this rejection the Examiner wrote that,

"Müller discloses a device for collecting and processing folded printed

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products that includes a collection drum (14) with uniformly distributed saddles (18) and conveyor elements (34); conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46"); a conveyor unit (48); and working stations (82, 74)."³

Ignoring *arguendo* the question of whether this observation may be a true characterization of Müller '278, it is not faithful to the definition of Applicant's inventions set forth in claim 1 or in newly presented claim 16; moreover, as is demonstrated in the following paragraphs, this statement is not supported by the evidence of record in this application. Full consideration of all of the evidence of record is required in making a determination under 35 U.S.C. §102(b).

Müller '278 claims priority from Swiss patent No. CH19940001316 199440428, and was published as EP0681979 (B1). The evidence of record, as set forth in Applicant's original specification, identified Müller '278 as EP -B1-0681979.⁴ As explained by Applicant in the original specification, Müller '278 contemplates a structure with,

"[o]ne possibility for the flexible use of space for various working steps is disclosed in EP-B1-061979. With this device for collecting and processing folded printed products a collection drum is combined with a revolving conveyor means. The collection drum in the usual manner serves the collection of the printed products. The collected printed products are transferred to the revolving conveyor means and here may be subjected to further working steps, i.e., adhesive binding or stapling, wherein adhesive binding is shown in detail in EP-A1-0675005. The axial direction of the collection drum and the conveyor direction in the revolving conveyor means ... [being] perpendicular to one another On collection of the printed products these are moved along on the rests to a first collection drum end. The collection drum end is determined by the end of the rests of the collection drum. The

³ Paper No. 04072005, page 4.

⁴ Original specification, paragraph [0010], lines 11 and 12.

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hub of the collection drum on the other hand extends beyond the end of the collection drum. The revolving conveyor means is arranged adjacent to the collection drum end. Chains which serve as conveyor devices in the revolving conveyor means and engage radially on the inside of its rests are led around that part of the hub projecting beyond the collection drum end. **This part of the hub thus serves as diverting means in the revolving conveyor means and thus becomes an integral part of this.** A *common drive* thus simultaneously provides for the rotation movement of the collection drum and for the conveyor movement of the rests in the revolving conveyor means. The distance between the rests moved in the revolving path is dimensioned such that these, when they are conveyed in the region of the collection drum, are flush with the rests of the collection drum, by which means a simple transfer of the printed products from the collection drum to the revolving means, based on the same design, may be transferred to a further collection drum arranged displayed to the first collection drum but may also be led back to the first collection drum on a lower side ... of the revolving conveyor means and transferred to a further collection section of the first collection drum.”⁵

The difficulty with the structure disclosed in Müller ‘278 is then discussed by Applicant in paragraph

[0011]:

“[a]lthough this design permits a higher flexibility of the use of space, however with this device too the use of the space is *restricted* since the folded printed products in each case may only be transferred in the diverting region of the revolving conveyor means from the collection drum to the conveyor means and from the conveyor means to the collection drum.”⁶

In contradistinction, claim 1 defines a structure with “the conveyor means in the transfer region is arranged adjacent to a collection drum end of the collection drum” This feature is not found in Müller ‘278. Under 35 U.S.C. § 102(b), it is error to assume that two structures are the same or

⁵ Original specification, paragraph [0010]; emphasis added.

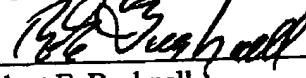
⁶ Original specification, paragraph [0011].

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equivalent simply because they perform the same function. The Federal Circuit has held it error to assume that two structures are the same or equivalent simply because they perform the same function. *Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1126-27 (Fed. Cir. 1996); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987) (en banc) ("Pennwalt erroneously argues that, if an accused structure performs the function required by the claim, it is per se structurally equivalent"), *cert. denied*, 485 U.S. 961 (1988). Infringement (or anticipation) is found only if the claimed function is performed by either the same structure (or acts) that the specification describes or else by an equivalent of the structure (or acts). *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 805 F.2d 1558, 1562, 231 USPQ 833, 834-35 (Fed. Cir. 1986). Accordingly, this rejection is improper under the all elements rule. Withdrawal of the rejection and allowance of claims 1 through 16 is respectfully requested.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,


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